



UNITED STATES PATENT AND TRADEMARK OFFICE

54
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,147	06/03/2002	Peter Himmelsbach	100718-/Beiersdorf748-KGB	8548
7590	02/26/2004			
Norris McLaughlin & Marcus 30th Floor 220 East 42nd Street New York, NY 10017				
			EXAMINER ZIRKER, DANIEL R	
			ART UNIT 1771	PAPER NUMBER

DATE MAILED: 02/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

101009147

Applicant(s)

Examiner

Group Art Unit

1771

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 12/10/03
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-28 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 2-28 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some* ☐ None of the:
 - ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit 1771

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 2-28 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More particularly, while the Examiner is willing to overlook certain formalities such as were set forth in paragraph No. 1 of the initial Office action, applicants' amendment to characterize their invention as a "combination" which is present in all of their claims is simply deemed unacceptable inasmuch as it is both vague, indefinite and confusing. The Examiner again respectfully suggests that terms such as "medical article", "cohesive dressing" or such similar terms would be far more meaningful if used to describe the claimed invention in all of applicants' claims. Additionally, in claim 14, lines 3 and 4 there is no antecedent basis for "said substrate".

3. Claims 2-28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over EP -942 combined with applicants' disclosures concerning the reference at page 2, fourth complete paragraph of the specification, taken individually or in view of applicants' further admissions set forth at page 1, second paragraph of the specification, substantially for the reasons set forth in paragraph No. 5 of the initial Office action, together

Art Unit 1771

with the following additional observations. The Examiner initially wishes to note that the preferred thermoplastic rubber-type block copolymer component of SEBS type is disclosed in EP -942 at page 4, lines 20-21, which is the SEBS block copolymer utilized by applicants in Examples 3-5 of the specification. As such, contrary to applicants' arguments (Response, page 16) the Examiner believes that the performance parameters claimed by applicants would be either inherent, since the compositions appear to be made from essentially the same composition as applicants disclose, or be but a minor modification thereof. Applicants have contested the Examiner's reliance upon EP -942, but nowhere can be found an example of a suitable comparison between the embodiments that would constitute the closest prior art of the claimed invention. As such, the applicants' argument (Response, page 17, top paragraph) that the Examiner has failed to make out his theory of inherency, is respectfully disagreed with. In summary, applicants have failed to rebut the prima facie case of record.

4. The Examiner thanks applicants for bringing to the Examiner's attention in his response the U.S. Patent Application Publication No. 2001/0051482A1, and accordingly has made it of record with this action.

5. Applicants' amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P.

Art Unit 1771

§ 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be

Serial No. 10/009,147

-5-

Art Unit 1771

reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-0994.

Dzirker:cdc

February 10, 2004

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP 1300

1700

Daniel Zinker